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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Payroll Institute

Serial No. 75/594,821

John W. Hazard, Jr. of Webster, Chamberlain & Bean for American Payroll Institute.

Michael J. Badagliacca, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Simms, Hairston and Drost, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

American Payroll Institute (applicant), a New York corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark ESSENTIAL PAYROLL SKILLS for educational instruction books.[1] The Examining Attorney has refused registration because applicant's mark is the title of a single work, and as

[1] Application Serial No. 75/594,821, filed November 24, 1998; amended to the Supplemental Register on October 19, 1999. The application asserts use and use in commerce since September 1998.

such, does not function as a trademark. The mark as used on the specimen of record is reproduced below (in reduced form). Applicant and the Examining Attorney have submitted briefs, but no oral hearing was requested.[2]

[2] Despite the fact that applicant amended this application to seek registration on the Supplemental Register, the Examining Attorney continued to refuse registration under Sections 1, 2 and 45 of the Trademark Act. After this application was amended to one seeking registration on the Supplemental Register, the appropriate refusal was under Section 23 of the Trademark Act, 15

We affirm.

Applicant argues that its mark functions as a trademark to identify its goods because the mark is used to denote a series of books used in educational courses. While applicant states that this title is for a series of publications rather than the title of a single publication, it is clear from applicant's submissions that the specimen of record represents a single work which applicant apparently intends to change periodically. That is to say, although applicant states that the asserted mark is used "to denote a series of books, not one single book," applicant also indicates that the "specimen of record is the first of many books that will be published bearing this mark." Reply brief, 1. Further, applicant indicates that the use of this mark is "new," and that therefore applicant does not have an entire series to show the Examining Attorney. Applicant also argues that it has filed and registered other marks on the basis of similar specimens.

The Examining Attorney argues that applicant's asserted mark does not function as a trademark because there is no evidence that applicant uses the mark to identify more than one publication. Indeed, in the first

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USC § 1191. See In re Eilberg, 49 USPQ2d 1955, fn. 2 (TTAB 1998).

Office Action the Examining Attorney noted that, if applicant uses the mark to identify a series of books rather than a single work, then applicant should provide evidence to demonstrate this fact for the record, and the Examining Attorney indicated that he would withdraw the refusal. Under existing case law, according to the Examining Attorney, applicant's asserted mark defines a distinct genus of goods and does not indicate source. See In re Cooper, 254 F.2d 611, 117 USPQ 396 (CCPA 1958), *cert. denied*, 358 U.S. 840, 119 USPQ 501 (1958). In this regard, the Examining Attorney notes the following language from *Cooper*, 117 USPQ at 400;

> The name for a series, at least while it is still being published, has a trademark function in indicating that each book of the series comes from the same source as the others. The name of the series is not descriptive of any one book and each book has its individual name or title. A series name is comparable to the title of a periodical publication such as a magazine or newspaper. While it may be indicative either specifically or by association in the public mind, of the general nature of the contents of the publication, it is not the name or title of anything contained in it. A book title, on the other hand especially one which is coined or arbitrary, identifies a specific literary work, of whatever kind it may be, and is not associated in the public mind with the publisher, printer or bookseller -- the "manufacturer or merchant" referred to in the Trademark Act (Sec. 45, definition of trademark). If a title is associated with anything, it is with the author for it is he who has produced the literary work which is the real subject of purchase.

Accordingly, the Examining Attorney maintains that titles of single works are not registrable as trademarks. Because applicant's asserted mark is used as the title of a single, individual work and not a series of books all bearing this asserted mark, the Examining Attorney maintains that the refusal should be affirmed.

Further, with respect to applicant's prior pending application and registration, the Examining Attorney notes that copies of these files are not in the record and that each case must be decided on its own merits, with prior decisions of different Examining Attorneys in other cases not binding on this Examining Attorney or the Board. The Examining Attorney maintains that he must examine registrability based upon the record in this case, which may involve different specimens, in the determination of the function this particular term performs. Here, the Examining Attorney argues, there is no evidence that the asserted mark functions as a trademark for a series of publications.

In In re Posthuma, 45 USPQ2d 2011 (TTAB 1998), the Board recently discussed the existing case law with respect to the registrability of titles of single works. Suffice it to say that, unless and until applicant uses the

asserted mark as a title for another publication, the mark remains unregistrable under existing precedent. Although applicant represents that it has received a registration of another mark covering educational instruction books, we must determine this appeal on the basis of the facts before us in this case, as the Examining Attorney has pointed out. Because the asserted mark is used only in connection with a single publication and not a series of publications, the asserted mark does not function as a trademark to identify and distinguish applicant's goods.

Decision: The refusal of registration is affirmed.